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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/307,356	05/07/1999	WILLIAM ALLAN	91436-171	4713

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EXAMINER

HSU, ALPUS

ART UNIT PAPER NUMBER

2665

20

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/307,356

**Applicant(s)**

ALLAN ET AL.

**Examiner**

Alpus H. Hsu

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,29-33 and 39-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 is/are allowed.
- 6) ☒ Claim(s) 1-4,30-33 and 39 is/are rejected.
- 7) ☒ Claim(s) 40 and 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. Applicant's arguments with respect to claims 1-4, 29-33, 39-41 have been considered but are moot in view of the new ground(s) of rejection.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claim 30 is rejected under 35 U.S.C. 102(b) as being anticipated by FARRIS in U.S. Patent No. 5,541,917 (newly cited).

Regarding claim 30, FARRIS discloses a method for establishing a voice call based on user input messages from a telephone, and setting up at least one non-telephony data services between the telephone and at least one data source during pendency of the voice call, providing the data service does not conflict with the voice call (see col. 6, lines 28-51).

4. Claims 31-33 are rejected under 35 U.S.C. 102(e) as being anticipated by GERSZBERG et al. in U.S. Patent No. 6,229,810 (of record).

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Regarding claim 31, GERSZBERG et al. discloses a method for retrieving a first configuration data structure for correlates user input elements with functions based on user input message from a telephone, and retrieving a second configuration data structure for correlates user input elements with functions different from those of the first configuration data structure based on further user input message from the telephone (see col. 5, lines 5-13).

Regarding claim 32, GERSZBERG et al. discloses a network intelligence for a data network, comprising a call service provider (38) for facilitating provision of telephony services for a plurality of data network telephones (14, 16, 18, 130) (see col. 2, lines 31-35, col. 9, lines 46-49, col. 10, lines 37-57), and a control messenger (100) for selectively sending control messages to enable or disable user input element of a given telephone to locally control a function at the given telephone (see col. 7, line 45 to col. 8, line 23).

Regarding claim 33, GERSZBERG et al. discloses the user input element comprises a volume control (see col. 7, line 64 to col. 8, line 1)

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over GERSZBERG et al. in U.S. Patent No. 6,229,810 (of record) in view of MOSS et al. in U.S. Patent No. 5,485,370 (newly cited).

Regarding claim 1, GERSZBERG et al. discloses a network intelligence for a data network, comprising a call service provider (38) for facilitating provision of telephony services for a plurality of data network telephones (14, 16, 18, 130) (see col. 2, lines 31-35, col. 9, lines 46-49, col. 10, lines 37-57), and at least one service proxy (22) for setting up at least one data service between at least one data source and the telephones (see col. 2, lines 25-28, col. 8, lines 39-51). GERSZBERG et al. differs from the claim, in that it does not implement the at least one service proxy within one or more terminal emulators, which is well known in the art for terminal emulation purpose. MOSS et al., from the similar of endeavor, teaches the use of intelligent terminal emulator for providing services to the terminals (see col. 3, line 56 to col. 5, line 60), which can be easily adopted by one of ordinary skill in the art into the system of GERSZBERG et al. to further improve the system efficiency for terminal emulation.

Regarding claims 2-4, GERSZBERG et al. discloses at least one configuration data structure for each telephone which correlates user input elements (such as key press indications) from the telephone with functions, providing different configuration data structures with different functions (see col. 5, lines 5-13).

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8. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over GERSZBERG et al. in U.S. Patent No. 6,229,810 (of record) in view of COOPER in U.S. Patent No. 5,790,671 (newly cited).

Regarding claim 39, GERSZBERG et al. discloses a network intelligence for a data network, comprising a call service provider (38) for facilitating provision of telephony services for a plurality of data network telephones (14, 16, 18, 130) (see col. 2, lines 31-35, col. 9, lines 46-49, col. 10, lines 37-57), and a messenger (100) for sending control messages to enable or disable user input element of a given telephone to locally control a function at the given telephone. GERSZBERG et al. differs from the claim in that it does not teach the control messages includes audio parameters for controlling audio at the telephones, which is well known in the art and commonly applied in communications field for audio response adjustment. COOPER, for example, from the similar field of endeavor, teaches the uses of audio parameters for in control messages for controlling audio at the remote devices (see col. 1, line 34 to col. 2, line 63), which can be easily adopted by one of ordinary skill in the art to implement in the system of GERSZBERG et al. to further improve the quality of service conforming the user specification and requirement.

9. Claim 29 is allowed.

10. Claims 40 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

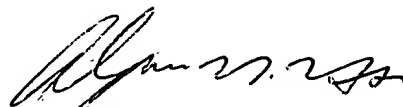
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11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpus H. Hsu whose telephone number is (703)305-4377. The examiner can normally be reached on M-F (5:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D. Vu can be reached on (703)308-6602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AHH



Alpus H. Hsu  
Primary Examiner  
Art Unit 2665